

II. Remarks

A. Introduction

Reconsideration and allowance of the present application are respectfully requested.

Claims 1-5, 10-12, 16-23, 25, 26, 28, 30-39 are pending in the present application.

Claims 1, 25 and 30 are independent. Claims 1, 10, 11, 12, 18, 19, 22, 23, 25, 28, and 30 have been amended. Claims 6-9, 13-15, 27 and 29 have been cancelled. Claims 32-39 have been added. No new matter has been introduced.

B. Action Summary

The Office Action states on page 2 that “any rejection of record that are not repeated below are considered withdrawn.” Applicant understands that there are no separate rejections of record for dependent Claims 16, 17, 21 and 26, except for being a dependent claim. Applicant confirmed this understanding on May 6, 2009 with Examiner Johann Richter.

C. Claim Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-23 and 25-31 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for using the term “substantially” in Claims 1, 18, 19, 22, 23, 25, and 30. The standard for evaluating indefiniteness is an objective standard of whether the claim scope is clear to a hypothetical person possessing the ordinary level of skill in the art. (*See* MPEP § 2171). The Office Action has set forth no evidence that a person possessing the ordinary level of skill in the art would view the claims to be indefinite. (*See Verve LLC v. Crane Cams Inc.*, 65 USPQ2d 1051, 1054 (Fed. Cir. 2002) (“It is well established that when the term “substantially” serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite.”)). However to expedite prosecution, Applicant has amended Claims 1, 18, 19, 22, 23, 25, and 30 to clearly indicate the scope of Applicant’s invention. Therefore, this rejection of Claims 1-23 and 25-31 is rendered moot.

D. Claim Rejections under 35 U.S.C. § 103(a)

Independent Claims 1, 25, and 30, as well as dependent Claims 2-15, 18-20, 22-24, and 27-29 stand rejected under 35 U.S.C. § 102(a) as being unpatentable over the combination of U.S. Patent No. 5,352,457 to Jenkins, et al. ("Jenkins") in view of U.S. Patent No. 6,037,280 to Edwards et al. ("Edwards"), WO02/059407 to Woods et al. ("Woods") and U.S. Patent No. 5,609,945 to von Trebra et al. ("von Trebra"). Applicant traverses this rejection in view of the amended claims and the arguments set forth below.

The Office Action alleges that Jenkins teaches a transdermal device having a backing layer, which may be a metallized polyester laminate, adjacent to an adhesive layer. Jenkins fails to teach the use of UV blocking agents as claimed, and the Office Action turns to Edwards and Woods to remedy the deficiency of Jenkins alleging that "the addition of an UV blocking agent would have been obvious to one of ordinary skill in the art as an additional means of blocking the harmful effect of UV radiation." (*See* Office Action, page 3). However, the combination of these three references cannot teach every element, so the Office Action relies on von Trebra to teach a metallized polyester film having 20% visible light transmission.

Independent Claim 1 recites a "patch applied to skin for reducing exposure to ultraviolet (UV) radiation" wherein "the second layer is transparent such that the skin is visible through the patch." Independent Claims 25 and 30 recite similar features. The alleged combination of references cannot teach every element of Claim 1. Jenkins teaches a transdermal device that has at least three layers, backing layer 6, layer 4, and release paper 2. (*See* Jenkins, FIG. 1). When applied to the skin, the release paper is removed and layer 4 is in direct contact with the skin. (*See* Jenkins, Col. 5, lines 47-51). Layer 4 of Jenkins contains the active ingredient that migrates into the skin. For Jenkins to be operational as a transdermal device, layer 4 must contact the skin, otherwise the active ingredient cannot migrate into the skin. The Office Action, alleges that the backing layer 6 of Jenkins, which does not contact the skin and covers layer 4 and which may be a metallized polyester film, would be transparent by virtue of the teachings of von Trebra. Von Trebra states that metallized polyester is 20% transparent. However, this does not teach every element of Claim 1 because Jenkins only teaches that the backing layer is a metallized polyester film, not the entire transdermal device. Also von Trebra teaches that its flexible sheet articles are translucent, i.e. diffuse light therethrough. (*See* von Trebra, Col. 1, lines 12-16). Even with the combination of Jenkins and von Trebra layer 4 would still be in direct contact with

the skin thereby preventing the skin from being visible through the patch as claimed. There is nothing in Jenkins to teach or suggest the skin is visible through the transdermal patch as claimed. Edwards and Woods are offered for teaching various UV blocking agents, and cannot remedy the deficiency of Jenkins and von Trebra. In particular, Edwards and Woods are related to textiles and garments, which inherently would not allow the skin that is covered to be visible through either the textile and/or garment. Thus, the combination of Jenkins, Edwards, Woods and von Trebra does not and cannot teach every element of independent Claims 1, 25, 30, and these claims, along with their dependent claims, are patentable over the cited references.

E. Conclusion

New independent Claim 39 recites a “patch applied to skin for reducing exposure to ultraviolet (UV) radiation” wherein “the first and second layers are transparent such that the skin is visible through the patch.” For the reasons discussed above with respect to Claims 1, 25 and 30, the cited references also do not teach every element of independent Claim 39.

F. Conclusion

In view of the above remarks, it is believed that this application is in condition for allowance, and a Notice thereof is respectfully requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3536. All correspondence should continue to be directed to the below-listed address.

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